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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Louis W. Blanco et al.
Serial No.: 10/691,483
Filed: October 22, 2003
Title: In-Car Video System Using Flash Memory As a Recording Medium
Art Unit: 2613
Examiner: Erick J. Rekstad
Confirmation No.: 5046
Docket No.: 9000/8

Mail Stop Appeal Brief- Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 1.136(a) AND APPEAL BRIEF UNDER 37 C.F.R. §41.37

Sir:

Applicants hereby petition the Commissioner to grant a three (3) month extension of time, up to and including Monday, September 11, 2006, in which to file an Appeal Brief following the Notice of Appeal filed April 5, 2006 (received by the U.S. Patent Office on April 11, 2006) in the above-identified application. The extension fee in the amount of \$510.00 may be charged to deposit account No. 50-1047. In addition, any deficiencies may be charged to deposit account No. 50-1047.

As set forth in the Notice of Appeal filed April 5, 2006, Appellant hereby appeals the final decision of the Examiner in the above-identified application rejecting the subject matter of the pending claims. Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's rejection of the claimed subject matter.

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I hereby certify that this document and any document referenced herein is being deposited with the US Postal Service as first class mail under 37 C.F.R. 1.8 and addressed to
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Marjorie Scariati
(Printed Name of Person Mailing Correspondence)

Marjorie Scariati
(Signature)

I. REAL PARTY IN INTEREST

L-3 Communications Mobile-Vision, Inc. is the assignee of the present invention and the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellant, Appellant's legal representative, or the assignees, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

This application was filed with Claims 1-20.

A first Office Action mailed on February 10, 2005 rejected Claims 1-4, 9-16 and 20 as being unpatentable over US Patent Application Publication US 2003/0095688 A1 (Kirmuss) in view of US Patent Application Publication US 2003/0112929 A1 (Chuang); and Claims 5-8 and 17-19 were rejected as being unpatentable over Kirmuss and Chuang in view of US Patent 5,794,164 (Beckert et al.).

A first Amendment, in response to the February 10, 2005 Office Action, was filed on Monday, July 11, 2005 – in that Amendment, Claims 8-11 and 17 were canceled and Claims 1, 12 and 18 were amended. Independent Claims 1 and 12 were amended to include the limitations of Claims 8 and 17, respectively.

A second, Final Office Action mailed on October 5, 2005 rejected Claims 1-7, 12-16 and 18-20 as being unpatentable over Kirmuss in view of Chuang and Beckert.

A Response to the Final Office Action was filed on March 6, 2006. There were no claim amendments in this response.

An Advisory Action was mailed on April 4, 2006.

A Notice of Appeal was mailed on April 5, 2006.

Claims 1-7, 12-16 and 18-20 are now pending and stand finally rejected. Claims 1 and 12 are the only independent claims. The rejection of each of the pending claims is appealed. The pending claims are set for in the Claims Appendix in Section VIII of this Brief.

IV. STATUS OF AMENDMENTS

A Final Office Action was mailed on January 10, 2006, finally rejecting Claims 1-7, 12-16 and 18-20. A Response to Final Office Action was filed on March 6, 2006. The Response to Final Office Action did not amend any claims. The Advisory Action mailed on April 4, 2006, indicated that the Response to Final Office Action was considered but did not place the application in condition for allowance.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The application describes an in-car video system, including a video camera fixably mounted to a vehicle for capturing an image of an event and producing a corresponding video stream, a digital video recorder fixably mounted to the vehicle, the digital video recorder having a receiving area being adapted to operably couple a flash memory card to the digital video recorder so that the flash memory functions as a digital video storage medium and a controller coupled to the video recorder to control writing of data that is representative of the video stream to a flash memory to thereby generate a stored video record of the event (Figure 1). The digital video recorder and controller are integrally packaged and sized to fit substantially within a factory-sized radio opening of a production vehicle having a police package option, and the digital video recorder is in a direct operative relationship with a user seated in the front seat of the vehicle (paragraphs [0018] – [0020]).

A method of operating a digital video recorder is described, in a vehicle-mounted video system including a car-mounted camera, the method including the steps of receiving a flash memory card in a receiving area of the digital video recorder, the receiving area being adapted to operably couple the flash memory card to the digital video recorder so that the flash memory functions as a digital video storage medium, receiving a video stream of an event captured by the camera, converting the video stream to a form that is writable to the flash memory, writing the converted video stream to the flash memory to thereby store a record of the event on the flash memory and fixably positioning the digital video recorder substantially within a dashboard area of the vehicle so that the digital video recorder is in a direct operative relationship with a user seated in the front seat of the vehicle (Figure 2, paragraphs [0024]-[0025]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant presents the following issue for review:

Would the subject matter of the appealed claims (Claims 1-7, 12-16 and 18-20) have been obvious to one of ordinary skill in the art at the time the invention was made from the combined disclosures of Kirmuss, Chuang and Beckert.

VII. ARGUMENT

The Appellant respectfully submits that the rejection of Claims 1-7, 12-16 and 18-20¹ is erroneous for the following reasons.

Independent Claim 1 is directed to an in-car video system, including a video camera fixably mounted to a vehicle for capturing an image of an event and producing a corresponding video stream, a digital video recorder fixably mounted to the vehicle, the digital video recorder having a receiving area being adapted to operably couple a flash memory card to the digital video recorder so that the flash memory functions as a digital video storage medium and a controller coupled to the video recorder to control writing of data that is representative of the video stream to a flash memory to thereby generate a stored video record of the event. The digital video recorder and controller are integrally packaged and sized to fit substantially within a factory-sized radio opening of a production vehicle having a police package option, and the digital video recorder is in a direct operative relationship with a user seated in the front seat of the vehicle.

Claim 12 is directed to a method of operating a digital video recorder, in a vehicle-mounted video system including a car-mounted camera, the method including the steps of receiving a flash memory card in a receiving area of the digital video recorder, the receiving area being adapted to operably couple the flash memory card to the digital video recorder so that the flash memory functions as a digital video storage medium, receiving a video stream of an event captured by the camera, converting the video stream to a form that is writable to the flash memory, writing the converted video stream to the flash memory to thereby store a record of the event on the flash memory and fixably positioning the digital video recorder substantially within

¹ Claims 1 and 12 are independent; Claims 2-7 depend upon independent Claim 1; Claims 13-16 and 18-20 depend upon independent Claim 12.

a dashboard area of the vehicle so that the digital video recorder is in a direct operative relationship with a user seated in the front seat of the vehicle.

As disclosed and claimed in the present invention, placing the digital video recorder (DVR) in the dashboard area of the car, puts it in a “direct operative relationship” with the operator (e.g., the police officer operating the vehicle and DVR) seated in the front seat of the vehicle. That is, in Applicant’s claimed invention, the DVR is in the *passenger compartment* with the operator (just as the normal sound system is in the passenger compartment).

Kirmuss does *not* teach or even suggest the invention as claimed where the digital video recorder is packaged in a small enclosure that fits within the passenger compartment of a police vehicle, and more specifically in the dashboard area of the vehicle that is normally occupied by the radio (i.e., the entertainment system radio/CD/cassette “head”...what is referred to in the specification as the factory-installed radio or sound system as compared with the two-way police radio that is installed by the police agency which operates the vehicle).

The Examiner agrees with Appellants that “Kirmuss does not specifically teach the installation in a DIN sized opening” (paragraph 2, page 5, February 10, 2005 Office Action, and paragraph 3, page 4, October 5, 2005 Final Action). However, the Examiner takes the position that Beckert teaches “the ability for a computer system to be produced that fits into the DIN location in the dash of a vehicle (col. 2, lines 2-21 and col. 3, lines 5-20)” (sentence bridging pages 2-3 of October 5, 2005 Final Action).

As ‘motivation’ to combine the alleged teachings of Kirmuss and Chuang with Beckert (which according to the Examiner teaches a smart card media reader sized to fit the standard DIN sized radio opening), the Final Action asserts (third paragraph, page 4) that Kirmuss teaches “the use of the embodiment in a compartment smaller than a PC or VCR-based system” and notes that “for a motorcycle, the embodiment may be mounted in a sealed radio compartment saddle” (paragraph [0152] of Kirmuss), and concludes that “it would have been obvious...to use the DIN size housing of Beckert with the system of Kirmuss and Chuang in order to place the system in the dash” (last full sentence, page 4 of Final Action).

Appellant again respectfully submits that the alleged impetus to combine Kirmuss with Beckert *simply does not exist*.

Kirmuss addresses, among other issues, the problem of heating/cooling of mobile video recorders (see paragraph [0037]). This problem is recognized in the prior art according to

Kirmuss since both VCR and PC-based (i.e., digital recorders) do not operate very well in extreme conditions (paragraphs [0011] and [0012]). Kirmuss mentions that very low temperatures (e.g., at or below 30° F), can cause operating problems or damage and extreme temperatures of 150° F or more are beyond what can be handled by current systems (paragraphs [0011] and [0012]).

Specifically, Kirmuss teaches an enclosure (or “airtight chassis”) for the event-recording device that is self-contained with heating and/or cooling systems and isolation from shock and vibration (see, e.g., paragraphs [0039], [0040], [0050 – 0052], [0152], [0164], [0189 – 0207]). Clearly, Kirmuss contemplates an environment for the DVR that is *separate from that of the operator*. In other words, Kirmuss very specifically teaches the need to heat and cool the DVR *separately*, whereby the DVR in the present invention is heated or cooled by the heating and/or air conditioner of the car as it is co-located with the operator *inside the passenger compartment*

Therefore, the motivation alleged in the Office Action to be found in Kirmuss, not only does not exist, but in fact Kirmuss *teaches away from* such an inventive concept – of providing a DVR in the passenger compartment of the vehicle.

Again, even assuming *arguendo* that Beckert discloses this teaching acknowledged to be missing from Kirmuss, Kirmuss cannot be combined with Beckert to arrive at the claimed invention because it is improper to combine references where the references *teach away from* their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Of course, a prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would *lead away from* the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Kirmuss teaches away from providing a DVR in the passenger compartment of a vehicle because Kirmuss teaches an enclosure for the DVR that is self-contained with heating and/or cooling systems and isolation from shock and vibration (i.e., *not within* the passenger compartment). The thermo-electric cooler (element 294 in Figure 2 of Kirmuss), that is noted by the Examiner in his Response to (Applicants’ previous) Arguments section of the Final Action, is part of the *solution* proposed by Kirmuss as discussed in detail in paragraphs [0189] to [0204] and show in Figures 7, 8 and 9. This solution is intended to keep the mobile video recorder within an operating range of approximately 30 to 125° F through the use of a shut off circuit (paragraph [0190]).

In addition, the Examiner states that Kirmuss includes a heating and cooling element (294) and that therefore the Applicant's argument that the "heating and cooling element would teach away from an automobile version is overcome by Kirmuss teaching such feature." Applicant would agree that Kirmuss teaches a device to provide device heating/cooling so that the Kirmuss system can monitor and regulate its own temperature (paragraph [0190]). Thus Kirmuss identifies a new structure using microprocessor-based temperature management (paragraph [0199]) to allow the video recorder to actively control its operating temperature from within a sealed enclosure (paragraph [0191]).

However, the Examiner appears to have misunderstood Applicants' assertion that this same heating and cooling element teaches *away from* locating a video recorder in the car dash as claimed. Placing the video recorder in an environment such as dash in the passenger compartment which is capable of being kept at a comfortable temperature for the car's human operator *obviates the need* for the structure disclosed in Kirmuss. The Examiner can not therefore properly combine Kirmuss with other references when the combination would change the basic principle of operation of the Kirmuss system. See, e.g., *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

The Advisory Action takes the position that "by using a solid state heat pump the digital recorder (in Kirmuss) can obtain proper operating temperature sooner than waiting for an entire vehicle to cool or heat" and therefore "it would have been obvious....to use the digital recorder of Kirmuss in a dash *because it does regulate its own temperature*" (Advisory Action, page 2, lines 13-15, emphasis added). Appellants again submit that the Kirmuss system uses microprocessor-based temperature management to allow the video recorder to actively control its operating temperature from within a sealed enclosure (paragraph [0191]). The statement in Kirmuss that the solid state heat pump uses a heat sink, simply does not, and would not, give rise to the requisite motivation, for one of ordinary skill in the art, to then turn to the alleged teachings of Beckert, and to further combine the alleged teachings in such a manner so as to arrive at Appellant's claimed invention.

Finally, the Advisory Action again directs Applicants to paragraph. [0152] of Kirmuss as teaching that the "digital recorder can fit into most compartments of the carrier vehicle", and notes that Beckett "provides a further example of a computer system which fits into a standard radio location within the dash" – Appellants respectfully submit that while Kirmuss does state

that its system is small and can fit “in most compartments of the carrier vehicle” (paragraph [0152]), the statement is too vague to provide the requisite suggestion that the video recorder be located in the dash as claimed in the present application. Kirmuss makes no explicit reference to using the dash area of a passenger compartment to locate the video recorder. Instead, the specific compartment noted by Kirmuss includes the vehicle’s trunk (paragraph [0012], [0199], and [0206]) *since this area can experience very high temperatures*. And even if, for the sake of argument, Kirmuss was viewed as impliedly suggesting the use of the dash area, the motivation to combine Kirmuss with other references is still lacking. In particular, the combination of Kirmuss with Beckert (US 5,794,164), which the Examiner states shows a computer system mounted in a dashboard, is not proper. For an implicit showing, the test is what “the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); see also MPEP §2143.01(I). Again, Appellant asserts that the nature of the problem in Kirmuss is *dealing with high temperatures in car trunks* as “rarely is the temperature of the space of trunks regulated, and the internal temperatures in the unregulated trunk often rise to 150° F or more” (paragraph [0012]). The Examiner has therefore not shown a proper basis for making the proposed combination of Kirmuss and Beckert under such a test.

For at least the foregoing reasons, each of independent Claims 1 and 12 is believed to be clearly patentable over any permissible combination of the teachings of Kirmuss, Chuang and Beckert. In addition, dependent Claims 2-7, 13-16 and 18-20 are believed patentable as depending from a patentable independent Claim 1 or 12, and for reciting further distinguishing limitations thereover.

Of course, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation *to make the necessary modification of the teaching of the references combined to result in the pending claims*. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP §§2142-2143; *In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 1596, 1598-99 (Fed. Cir. 1988). The teaching or suggestion to make the claimed *modification* and the reasonable expectation of success *must both be found in the prior art and not based on applicant's*

disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). 706.02(j) [emphasis added].

Thus, Appellant respectfully submits that Claims 1-7, 12-16 and 18-20 of the present invention are not taught or suggested by Kirmuss, Chuang and Beckert and would not be obvious in light of any combination of Kirmuss, Chuang and Beckert.

Appellant further respectfully submits that it is, of course, improper to pick and choose elements from several references in order to “build” an obviousness rejection, when such a combination would not in fact have been obvious to one of ordinary skill in the art. One of ordinary skill in the art would not have even considered turning to the alleged teachings of Beckert, without the teachings provided by Appellant’s disclosure – which, of course, is not a proper basis for rejection, as it is impermissible to use an Applicants’ specification as an instruction manual or “road map” to piece together the teachings of the prior art in order to render claims obvious. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). Since there is *no teaching* in these references that would suggest each of the elements recited in the present claims, even if one used impermissible hindsight and combined the teachings of the references, the present invention would still not be achieved.

Accordingly, Appellants respectfully submit that independent Claims 1 and 12, and dependent Claims 2-7, 13-16 and 18-20, of the present invention are not taught or suggested by Kirmuss, Chuang and Beckert, and would not be obvious in light of any combination of the teachings of Kirmuss, Chuang and Beckert.



Application SN
10/691,483

CONCLUSION

The references relied upon by the Examiner do not support a *prima facie* case of obviousness. Appellant submits that the pending claims, Claims 1-7, 12-16 and 18-20 are patentable over the art of record and it is respectfully requested that the Board reverse the final rejection of the subject matter of these claims for the reasons given above.

Respectfully submitted,


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VIII. CLAIMS APPENDIX

The claims involved in the appeal, Claims 1-7, 12-16 and 18-20 are reproduced below.

1. (Previously Presented) An in-car video system, comprising:
a video camera fixably mounted to a vehicle for capturing an image of an event and producing a corresponding video stream;
a digital video recorder fixably mounted to the vehicle, the digital video recorder having a receiving area being adapted to operably couple a flash memory card to the digital video recorder so that the flash memory functions as a digital video storage medium; and
a controller coupled to the video recorder to control writing of data that is representative of the video stream to a flash memory to thereby generate a stored video record of the event,
wherein the digital video recorder and controller are integrally packaged and sized to fit substantially within a factory-sized radio opening of a production vehicle having a police package option, and
further wherein the digital video recorder is in a direct operative relationship with a user seated in the front seat of the vehicle.
2. (Original) The in-car video system of claim 1 where the receiving area is further adapted so that the flash memory card is removably couplable to the digital video recorder.
3. (Original) The in-car video system of claim 1 where the flash memory is a flash memory card selected from the group consisting of Smart Media, Secure Digital, Multimedia Card, xD-Picture Card and Memory Stick.
4. (Original) The in-car video system of claim 1 where the flash memory is a CompactFlash card.
5. (Original) The in-car video system of claim 1 where the digital video recorder and controller are integrally packaged and sized to fit substantially within a standard single DIN sized radio opening.

6. (Original) The in-car video system of claim 1 where the digital video recorder and controller are integrally packaged and sized to fit substantially within a standard 1.5 DIN sized radio opening.

7. (Original) The in-car video system of claim 1 where the digital video recorder and controller are integrally packaged and sized to fit substantially within a standard double DIN sized radio opening.

8-11. (Canceled)

12. (Previously Presented) In a vehicle-mounted video system including a car-mounted camera, a method of operating a digital video recorder, the method comprising the steps of:

receiving a flash memory card in a receiving area of the digital video recorder, the receiving area being adapted to operably couple the flash memory card to the digital video recorder so that the flash memory functions as a digital video storage medium;

receiving a video stream of an event captured by the camera;

converting the video stream to a form that is writable to the flash memory;

writing the converted video stream to the flash memory to thereby store a record of the event on the flash memory; and

fixably positioning the digital video recorder substantially within a dashboard area of the vehicle so that the digital video recorder is in a direct operative relationship with a user seated in the front seat of the vehicle.

13. (Original) The method of claim 12 further including a step of reading the stored record from the flash memory.

14. (Original) The method of claim 13 further including a step of transmitting the record read from the flash memory to a remote monitor.

15. (Original) The method of claim 12 further including a step of removing the flash memory from the video recorder.

16. (Original) The method of claim 15 further including a step of storing the removed flash memory.

17. (Canceled)

18. (Previously Presented) The method of claim 12 where the dashboard area comprises a dashboard portion that is typically used to house a sound system.

19. (Original) The method of claim 18 where the dashboard portion is double DIN sized.

20. (Original) The method of claim 12 further including a step of receiving a second flash memory card in a receiving area of the digital video recorder, the receiving area being adapted to operably couple the flash memory card to the digital video recorder so that the second flash memory functions as a second digital video storage medium that automatically stores a portion of the video stream once the other flash memory card becomes full.

Serial No. 10/691,483

IX. EVIDENCE APPENDIX.

None

X. RELATED PROCEEDINGS APPENDIX

None.